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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/669,899	09/27/2000	Makiko Endo	35.C14832	4427

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EXAMINER

SHOSHO, CALLIE E

ART UNIT	PAPER NUMBER
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1714

11

DATE MAILED: 08/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/669,899

Applicant(s)

ENDO ET AL.

Examiner

Callie E. Shosho

Art Unit

1714

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 July 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.

Claim(s) objected to: None.

Claim(s) rejected: 1-15.

Claim(s) withdrawn from consideration: None.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Attachment to Advisory Action

1. Applicants' amendment filed 7/24/02 has been carefully considered. However, the amendment has not been entered given that it raises new issues that would require further consideration and search. Claims 1 and 11 have been amended to recite that the colored resin particle comprises a film-forming resin "to which a dye is sublimed and penetrated and wherein the film-forming resin is an acrylic resin". It is the examiner's position that this phraseology is new and would require further consideration and search by the examiner. Furthermore, there is no reason why applicants could not have presented such an amendment earlier.

Also, the amendment raises new issues under 35 USC 112, second paragraph. Claim 5 recites the limitation "the colorant" in line 2. There is insufficient antecedent basis for this limitation in the claim given that claim 1, on which claim 5 depends, does not disclose a colorant but rather has been amended to recite a dye.

Further, it is noted that even if the amendment were entered, it is the examiner's position that the amendment would not overcome the rejections of record with respect to EP 130789. Applicants argue that EP 130789 (Shintani et al.) discloses colored polyethylene resin as the colorant and that there is no disclosure that the dye is incorporated into the polymer fine particles through sublimation.


However, it is noted that page 4, line 26-page 5, line 12 of EP 130789 discloses that the polymer is obtained from monomers including (meth)acrylate and thus, EP 130789 does disclose acrylic resin as required in the present claims. Further, page 11, line 24-page 12, line 2 of the present specification discloses that sublimation occurs by adding a dye to fine particulate resin dispersion and heating with agitation for a certain period of time. Similarly, example 26 of EP

130789 discloses making the colored polymer by adding dye to aqueous polymer emulsion and then stirring the mixture at 95 °C for 60 minutes. Thus, while there is no explicit disclosure of sublimation in EP 130789 given that EP 130789 disclose adding dye to polymer and heating with agitation for a certain period of time which is the same method utilized in the present invention to achieve sublimation, it is the examiner's position that the dye in EP 130789 is in fact sublimated and penetrated into the polymer.



Callie Shosho

8/5/02


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